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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/003,225	10/30/2001	John B. Paine III	PM 1906 (4981*355)	5034
7590	02/20/2004		EXAMINER	
LAW OFFICES CONNOLLY BOVE LODGE & HUTZ LLP 1220 MARKET STREET P.O. BOX 2207 WILMINGTON, DE 19899			WALLS, DIONNE A	
		ART UNIT	PAPER NUMBER	
		1731		
DATE MAILED: 02/20/2004				

Please find below and/or attached an Office communication concerning this application or proceeding.

AS

<b>Office Action Summary</b>	Application No.	Applicant(s)
	10/003,225	PAINE, JOHN B.
	Examiner	Art Unit
	Dionne A. Walls	1731

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

1) Responsive to communication(s) filed on 07 November 2003.

2a) This action is FINAL.      2b) This action is non-final.

3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

4) Claim(s) 1-14 is/are pending in the application.

4a) Of the above claim(s) 3-5 is/are withdrawn from consideration.

5) Claim(s) \_\_\_\_\_ is/are allowed.

6) Claim(s) 1 and 6-10 is/are rejected.

7) Claim(s) 11-14 is/are objected to.

8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

9) The specification is objected to by the Examiner.

10) The drawing(s) filed on \_\_\_\_\_ is/are: a) accepted or b) objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a) All    b) Some \* c) None of:

1. Certified copies of the priority documents have been received.

2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.

3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

1) Notice of References Cited (PTO-892)

2) Notice of Draftsperson's Patent Drawing Review (PTO-948)

3) Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_

4) Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_

5) Notice of Informal Patent Application (PTO-152)

6) Other: \_\_\_\_\_

## DETAILED ACTION

### ***Claim Rejections - 35 USC § 103***

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

2. Claims 1 and 6-10 are rejected under 35 U.S.C. 103(a) as being unpatentable over Smith (U.S. Pat. No. 1,559,054).

Smith discloses charcoal (i.e. activated carbon) that can be used as filtering material, said charcoal having a heavy metal (i.e. nickel, copper, zinc, etc) "evenly distributed throughout the crude material so as to become an integral part of the charcoal formed upon burning" the charcoal at temperatures ranging from 700 to 1300 degrees F (371 – 704 degrees C) (see entire document). While Smith may not specifically state that the heavy metal is incorporated within the "graphitic sheets" of the charcoal, it follows that since Smith teaches that the metal is "intimately impregnated" into the "structure" of the charcoal, this is obviously an indication that the metal is incorporated within the carbon structure, as opposed to merely deposited or resting upon the surface of the carbon. Further, while Smith may not state that its charcoal is used as filtering material for a smoking article, as is recited in the claims, it would have been obvious to one having ordinary skill in the art at the time of the invention to utilize the charcoal filtering material of Smith in a cigarette filter, to be attached to a smoking article, since using activated carbon in such filters is conventional in the tobacco art.

Regarding claim 10, it is a product-by-process claim and, accordingly, the standards set forth in MPEP 2113 will be followed. Even though product-by-process claims are limited by and defined by the process, determination of patentability is based on the product itself, i.e. differences in product characteristics, and not on its method of production.

3. Claims 1 and 6-10 are rejected under 35 U.S.C. 103(a) as being unpatentable over DD 218075 (English Derwent Abstract).

DD 218075 discloses activated carbon that can be used to purify air, said activated carbon having a heavy metal (i.e. iron, nickel, cobalt) added to it before heating to 850-1000 degrees C. (see entire abstract). While DD 218075 may not specifically state that the heavy metal is incorporated within the "graphitic sheets" of the charcoal, it follows that since Smith teaches that the metal is added to the carbon before heating at high temperatures (consistent with those that Applicant has disclosed in the instant specification), the metal would be incorporated within the carbon structure, as opposed to merely deposited or resting upon the surface of the carbon which, Applicant contends, occurs at much lower temperatures. Further, while DD 218075 may not state that its charcoal is used as filtering material for a smoking article, as is recited in the claims, it would have been obvious to one having ordinary skill in the art at the time of the invention to utilize the charcoal material of DD 218075 in a cigarette filter, to be attached to a smoking article, since using activated carbon in such filters is conventional in the tobacco art.

Regarding claim 10, it is a product-by-process claim and, accordingly, the standards set forth in MPEP 2113 will be followed. Even though product-by-process claims are limited by and defined by the process, determination of patentability is based on the product itself, i.e. differences in product characteristics, and not on its method of production.

***Allowable Subject Matter***

4. Claims 2 and 11-15 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

***Response to Arguments***

5. Applicant's arguments with respect to claims 1-2 and 6-15 have been considered but are moot in view of the new ground(s) of rejection.

***Conclusion***

6. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

- Golden et al (US. Pat. No. 5,540,749)

7. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within

TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Dionne A. Walls whose telephone number is (571) 272-1195. The examiner can normally be reached on Mon-Fri, 7AM - 4:30PM (Every other Friday off).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Steven P. Griffin can be reached on (571) 272-1189. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

  
Dionne A. Walls

Application/Control Number: 10/003,225  
Art Unit: 1731

Page 6

Primary Examiner  
Art Unit 1731

February 11, 2004